

3 a desktop device capable of communicating information, and
4 a hand-held device capable of communicating information.

1 *BHT*
2 *E*
3 72. (New) The apparatus of claim 45, wherein the
4 apparatus is capable of receiving the request from any one
5 of the following: a desktop device capable of communicating
information, and a hand-held device capable of communicating
information.

REMARKS

Upon entry of the present Amendment, the claims in the application are claims 1-72. Claims 37-72 are new. Applicant respectfully submits that the subject matter of new claims 37-72 is fully supported in the specification as originally filed. No new matter has been introduced.

Claim 26 is objected to for depending from claim 20, and has been amended as requested in the final Office Action.

Claim 2 stands rejected under 35 U.S.C. 112, second paragraph, for use of the term "represented as". Claim 2 has been amended to recite that the recited domain name element has the form

INEEDSUBJECT.XXX. The rejection of claim 2 under 35 U.S.C. 112 is believed to be overcome.

Claims 1-3, 6-7 and 9 stand rejected under 35 U.S.C. 102(a) as being anticipated by Traderonline.com (Press release, dated September 22, 1998, hereinafter "Traderonline.com"). In addition, claims 4, 8, 10-21, 24-25, and 28-36 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Traderonline.com in view of Gupta et al. (U.S. Publication US2001/0020242A1, hereinafter "Gupta"). In response to the claim rejections, Applicant submits the following.

Concerning claims 1, 18 and 25

Claim 1 has been amended to recite the steps of maintaining a database of personal information relating to a consumer, the personal information having been previously provided by the consumer and including consumer-identified preferred providers; selecting, responsive to a request initiated by the consumer and based upon the personal information relating thereto, a name of at least one provider; and forwarding the name of the at least one provider to the consumer for choosing to communicate therewith. Because the invention of claim 1 allows for the selection of at least one provider to be based upon stored personal information of the consumer including consumer-identified preferred providers, the

selection is advantageously personalized and/or customized without the consumer having to manually provide the personal information.

Similarly, claim 18 recites a database of consumer-provided information including consumer-identified preferred providers, and selecting a provider based upon the information. Claim 25 recites storing consumer-provided information including consumer-identified preferred providers.

In contrast, Traderonline.com shows a first web page, traderonline.com, having hyperlinks to various other web pages, including boattraderonline.com and autotraderonline.com, at which information regarding the sale of various boats and automobiles, respectively, are provided. Searches may be performed by a consumer manually providing the particulars of a boat/auto of interest to the consumer. However, Traderonline.com does not show or suggest performing searches or otherwise selecting a provider based upon personal information relating to a consumer stored in a database. This is admitted in the final Office Action (see page 5 of the final Office Action).

It is contended in the final Office Action that Gupta shows storing personal preferences, payment instructions and demographic information and using same in selecting a provider. In fact, Gupta shows collecting consumer information by an ISP through monitoring the consumer's online activity. The consumer information is secretly collected, relative to the consumer (paragraph 55). The

secretly collected consumer information includes demographic information of the consumer, web sites frequented by the consumer, other user network access by the consumer and information relating to searches conducted by the consumer (paragraphs 55 and 57). Applicant respectfully submits that the database of secretly-collected consumer information, based upon monitoring the online activity of the consumer, as described in Gupta is in marked contrast to maintaining/storing consumer-provided information including consumer-identified preferred providers, as recited in claims 1, 18 and 25. Because the database in Gupta is based mostly upon observations of the online activity of the consumer, it cannot be said that the proposed combination of teachings of Traderonline.com and Gupta shows or suggests a database of consumer-provided information, including preferred providers identified by the consumer, and selecting a provider based upon the consumer-provided information in the database. As a result, Applicant respectfully submits that claims 1, 18, 25 and the claims that depend therefrom are allowable over Traderonline.com and Gupta.

Concerning claims 2, 20 and 28

Claims 2, 20 and 28 recite that the consumer-initiated request includes a domain name associated with a plurality of domain names, each of which includes a common domain name element, the domain

name element identifying goods/services without identifying a specific provider, and that the selecting is responsive to the request and is based upon the personal consumer information. In the final Office Action, it is contended that Traderonline.com shows a request having a common domain name element "traderonline", and a subject of, for example, "boat" or "auto". This makes the request of the form "boattraderonline.com" or "autotraderonline.com". This type of request obviously is entered into the command line of a web browser. Entering "boattraderonline.com" or "autotraderonline.com" causes the browser to automatically display the boattraderonline.com or autotraderonline.com web page, respectively. The requests/commands "boattraderonline.com" and "autotraderonline.com" identified in the final Office Action as appearing in the Traderonline.com reference are simply commands to display in the online browser of the consumer either the boattraderonline.com or autotraderonline.com web page. If these commands are indeed considered requests, then the selection (i.e., providing in the web browser) of the requested web page in response to the request clearly is not based upon consumer information maintained in a database, as recited in claims 2 (due to claim 2 depending from claim 1), 20 and 28. It cannot be said that Traderonline.com, Gupta or any other reference of record suggests selecting a web page responsive to a command/request (either "boattraderonline.com" or

"autotraderonline.com") such that the selection is also based upon other information, in this case consumer information. In an absence of any teaching or suggestion of the invention of claims 2, 20 and 28, Applicant respectfully submits that claims 2, 20 and 28 are allowable.

Concerning claims 10, 11, 26

Claims 10 and 26 recite that the personal information includes consumer-submitted privacy instructions, and the method further comprises enabling the consumer to purchase from a selected provider in accordance with the stored, consumer-submitted privacy instructions. It is clear that Traderonline.com fails to discuss the use of privacy instructions in any way. With respect to Gupta, there is no showing or suggestion of enabling a consumer to make a purchase based upon stored, consumer-provided privacy instructions. Claims 10 and 26 are believed to be allowable as a result.

Claim 11 recites that the privacy instructions include instructions to make information alternatively, freely available, available only when consumer-authorized or never available to the provider. Neither Traderonline.com nor Gupta show or even remotely suggest this feature. Claim 11 is believed to be allowable.

Concerning claims 12, 13 and 29

Claim 12 recites the step of enabling the consumer to purchase in accordance with payment instructions submitted by the consumer and stored in the database. It is clear that Traderonline.com fails to discuss the use of consumer-provided payment instructions in any way. With respect to Gupta, there is no showing or suggestion of enabling a consumer to make a purchase based upon stored, consumer-provided payment instructions. Claim 12 is believed to be allowable as a result.

Claims 13 and 29 recite that the payment instructions allow the consumer to transact with the chosen provider in an anonymous manner. It is clear that Traderonline.com fails to show this feature. In addition, Gupta fails to show or suggest payment instructions including an instruction to complete transactions in an anonymous manner. Claims 13 and 29 are believed to be allowable as a result.

Concerning claims 14, 15 and 30

Claim 14 recites that the payment instructions include instructions to complete transactions using a card number of the system and to rebill the consumer for completed transactions. Relatedly, claim 30 recites that the anonymous manner allows the consumer to transact business with the chosen provider using a payment method of the system and to be rebilled thereby for the transaction. Clearly, it cannot be said that the combination of

Traderonline.com and Gupta show or even remotely suggest this feature of transacting using a system's payment method and billing the consumer for the transaction. Claims 14 and 30 are believed to be allowable.

Claim 15 recites the payment instructions include instructions to complete transactions according to a predetermined payment arrangement with the chosen provider. Traderonline.com fails to show or suggest this feature. Because Gupta is directed to secret monitoring of online consumer activity, Gupta does not show or suggest the use of predetermined payment arrangements. Claim 15 is believed to be allowable as a result.

Concerning the new claims

New claims 37 and 45 recite maintaining a database of personal information of the consumer, identifying one or more providers of the type requested by the consumer, and enabling the consumer to complete a transaction with a provider of the one or more providers using the personal information in the database. In this case, Traderonline.com fails to show or suggest the particulars of how a transaction is completed with a seller of goods. The Gupta reference is primarily directed to providing target advertising to a consumer by monitoring consumer activity without the consumer's knowledge. The Gupta reference therefore does not show or suggest facilitating a transaction with a provider chosen by the consumer

by using personal information stored in a database. New claims 37 and 45 and the claims that depend therefrom are believed to be allowable as a result.

New claims 40 and 48 recite that the personal information maintained in the database includes consumer-provided instructions that transactions are to be completed without using payment information relating to the consumer, and that the consumer is to be separately billed for the transactions. It is clear that both Traderonline.com and Gupta fail to show this feature. Claims 40 and 48 are believed to be allowable.

New claims 41 and 49 recite that the personal information comprises a consumer-provided instruction that the identity of the consumer is not to be communicated with the chosen provider in completing the transaction. Because Traderonline.com does not delve into the particulars of completing a transaction and because Gupta is directed to the secretive collection of consumer information and the use of same in providing target advertising to the consumer, the invention of claims 41 and 49 are believed to be allowable over the references relied upon the outstanding Office Action.

New claims 53 and 61 recite maintaining/storing personal information in a database; receiving a request including a domain name associated with a plurality of domain names each of which includes a common domain name element; selecting, responsive to the

received request and based upon the personal information, at least one name of at least one provider; and forwarding the selected at least one name to the consumer. As stated above with respect to claim 2, the Traderonline.com reference shows receiving a web address (autotraderonline.com or boattraderonline.com) in the command line of a web browser. Entering "boattraderonline.com" or "autotraderonline.com" causes the browser to automatically display the boattraderonline.com or autotraderonline.com web page, respectively. If these commands are indeed considered requests, then the selection (i.e., providing in the web browser) of the requested web page in response to the request clearly is not based upon consumer information maintained in a database, as recited in new claims 53 and 61. It cannot be said that Traderonline.com, Gupta or any other reference of record suggests selecting a web page responsive to a command/request (either "boattraderonline.com" or "autotraderonline.com") such that the selection is also based upon other information, in this case consumer information. In an absence of any teaching or suggestion of the invention of new claims 53 and 61, Applicant respectfully submits that claims 53-68 are allowable.

New claims 69 and 71 recite that the step of receiving receives the request from any one of the following: a desktop device capable of communicating information, and a hand-held device capable of communicating information. In addition, claims 70 and

72 recite that the server is capable of receiving the request from any of the following: a desktop device capable of communicating information, and a hand-held device capable of communicating information. The claimed invention, therefore, advantageously allows for services to be provided as claimed regardless of whether the request was initiated from a hand-held or desktop communication device.

In contrast, Traderonline.net is merely directed to selecting a particular web page to be displayed and thereafter searching for a desired vehicle from the web page. Gupta is directed to information gathering by an ISP or proxy. There is no showing or suggestion in Gupta or elsewhere of an online provider being capable of maintaining and using a database of consumer information and monitoring consumer activity from a variety of communication devices, including a desktop communication device and a hand-held communication device, such as a mobile telephone or a PDA. In an absence of any prior teaching of the invention of new claims 69-72, claims 69-72 are believed to be allowable.

Marked up versions of the amended claims showing all the changes relative to the previous version of such claims appear above. Attached to the present Amendment as an appendix is a clean copy of the claims as amended.

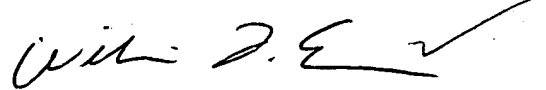
Patent Application
44660-1

In view of the above, it is believed that this application is in a condition for allowance, and such a Notice is respectfully requested.

Favorable consideration is respectfully requested.

Respectfully submitted,

JENKENS & GILCHRIST, P.C.



William F. Esser
Reg. No. 38,053

Date: July 11, 2002

Jenkins & Gilchrist
1445 Ross Avenue, Suite 3200
Dallas, Texas 75202-2799
214/855-4181
214/855-4300 (fax)